

## REMARKS

### 35 USC § 112

The examiner rejected Claims 1-17 and 33-39, 41-49 under 35 U.S.C. 112, second paragraph, as being indefinite.

The examiner stated:

Independent claim 1 recites the limitation "the order of a type that is executable against any participant that can at least in part satisfy at least a portion of the specified quantity of the order" is interpreted as non-functional descriptive material because it only describes the order. It does not in any material way affect the step of entering the order. There is nothing in the cited limitation that shows how the entering step is altered as a result of the description of the order. This claim further recites the limitation "the graphical user interface allowing the user to form the order and the graphical user interface including a field that allows the user to choose a priority type for how the order interacts with contra side quotes/orders in the trading venue" is interpreted as non-functional descriptive material because it only describes the information in the graphical user interface (GUI). It does not in any material way affect the step of the display rendering a graphical user interface. There is nothing in the limitation that further limits how the graphical user interface is rendered. Also the metes and bounds of the limitations "allowing the user to form the order" and "that allows the user to choose" are unclear. Specifically it is not clear as to what is the result of allowing the user to form the order. Is the order formed or is it not? Similar reasoning applies to allowing the user to choose. Allowing a user to perform a function does not necessarily imply that the function is performed. Dependent claims are rejected by way of dependency on a rejected claim.

Claim 1 is definite within the meaning of 35 U.S.C. 112, second paragraph. Claim 1 includes the feature of "a display, coupled to the computing system, the display rendering a graphical user interface, the graphical user interface allowing the user to form the order and the graphical user interface including a field that allows the user to choose a priority type for how the order executes with contra side quotes/orders in the trading venue." One of ordinary skill would be able to understand the metes and bounds of this feature.

The examiner appears to confuse the requirements of 112, second paragraph with the requirements of 102 and 103, by arguing that certain features of the claim are not entitled to patentable weight. The examiner has not set forth any authority for the proposition that a claim

can be rejected under 35 U.S.C. 112, second paragraph because in the examiner's opinion certain features are not entitled to patentable weight. If the examiner is aware of any authority, Applicant requests that the examiner cite it. Further, Applicant contends for reasons discussed below for the rejections under 35 U.S.C. 102 and 103 that all of the features of claim 1 are entitled to patentable weight.

With regard to the argument concerning "allowing," Applicant disagrees, but in order to advance prosecution has amended the claim. Accordingly this rejection should be removed.

The examiner stated: "Claim 2 recites "wherein the client system is coupled to a network" and "a server system coupled to the network". It is not clear if the network is a part of the claimed system. Hence the scope of the claim is unclear. This claim also recites "The system of claim 1 wherein the client system is coupled to a network, the system further comprising a server system". It is not clear as to which system further comprises a server system. Is it the client system or the "main" system in claim 1." Claim 2 is clear on its face. The claim requires the client system is coupled to a network, and clearly the system referred to is the system of claim 1.

The examiner stated: "Claims 8-16 recite the limitations "the server" or "the server system". These limitations lack antecedent basis." Applicant has amended these claims to call for "server system." Also Applicant has amended claim 8 to depend from claim 2, which provides antecedent basis for "the server system."

The examiner also stated:

**Claim 33 recites the limitation "The computer program product of claim 29 further comprising instructions to cause a computer to". It is not clear if the computer in this claim is the same computer in claim 29. Also as discussed in claim 1 above the limitation "the graphical user interface including a field that allows a user to form the order and to choose a priority type for how the order interacts with contra side quotes/orders in the trading venue" is not further limiting on the claim.**

Applicant has amended the claim to recite "the computer." As for the examiner's discussion regarding the interface, see above.

The examiner stated: "Claim 34 recites the limitation 'The client system including a display' and 'choosing by the client computer system'. The Examiner has interpreted both these systems to be 'the client computing system'." Applicant has clarified features of claim 34.

The examiner also stated:

Claims 34-39 claim a method but recite the features of a system (e.g. the client system including a display that renders a graphical user interface including a field for providing a priority type for how the order interacts with contra side quotes/orders in the trading venue). Claims 34-39 are not sufficiently precise due to the combining of two different statutory classes of invention in a single claim. The preamble the claim refers to a method, but the body of the claim discusses the specifics of a system. A claim is considered indefinite if it does not apprise those skilled in the art of its scope. *Amgen, Inc. v. Chugai Pharm.* Dependent claims 35-39 are rejected based on similar reasoning and by way of dependence on a rejected independent claim.

Applicant disagrees. Claim 34 is directed to a method, and recites positive steps that are carried out by a machine, namely a computer system. The claim is a proper method claim and one of skill in the art would be able to appreciate the metes and bounds of the subject matter being claimed, all that is required by 35 U.S.C. 112, second paragraph.

The examiner stated: "Claim 41 recites 'The system of claim 40 wherein the specified priority is that the order executes against contra side interest in price/time priority, and the system is further configured to'. It is not clear which system the Applicants are referring to. There are three different systems mentioned in claim 40. Claims 42-44 suffer from similar ambiguities." Applicant has made clarifying amendments.

The examiner stated: Claims 45-49 recite: "A computer program product for an electronic trading venue". It is not clear if the computer program product is a tangible or intangible product. The Examiner has broadly interpreted the computer program product to include an intangible product." Applicant has made clarifying amendments.

### 35 USC § 101

The examiner rejected Claims 34-39 and 45-49 under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter.

The examiner stated: "Claims 34-39 are intended to embrace or overlap two different statutory classes of invention as set forth in 35 § U.S.C. § 101. "A claim of this type is precluded by express language of 35 U.S.C. § 101 which is drafted so as to set forth statutory the statutory classes of invention in the alternative only", Ex parte *Lyell* (17 USPQ2d 1548)." These claims are directed to a method and are not directed to two statutory classes. Applicant suggests that the examiner re-visit *Lyell* and observe that there was an explicit attempt to cover two statutory classes in the preamble of the claim decided by the court. *Lyell* does not preclude a claim to a method that operates by use of a machine such as a computer, as the examiner reasons.

Applicant's amended claim 45 clearly defines patent-eligible subject matter.

### 35 USC § 103

The examiner rejected Claims 1, 2, 5, 17, 29, 31-34, 37, 40, 44, 45 and 49 under 35 U.S.C. 103(a) as being unpatentable over May (US Pub No. 2002/0138390).

Claim 1 requires the features of: "a display ... rendering a graphical user interface ... to form the order and the graphical user interface including a field that ... to choose a priority type for how the order executes with contra side quotes/orders in the trading venue."

The examiner stated:

**Claim 1 May teaches a system for an electronic venue for trading of securities comprising: a client system for entering an order to buy or sell a specified quantity of a security, the order of a type (buy and sell are the order types) that is executable against any participant that can at least in part satisfy at least a portion of the specified quantity of the order (See the entire disclosure of May particularly Figure 2, 14-A); the client system including: a computing system (See the entire disclosure of May particularly Figure 2); a display coupled to the computing system (See the entire disclosure of May particularly Figure 2), the display rendering a graphical user interface, the graphical user interface allowing the user to form the order and the graphical user interface including a field that allows the user to choose a priority type for how the order interacts with contra side quotes/orders in the trading venue (See the entire disclosure of May particularly Figures 2, 14A-B, Paragraphs 273-276, 283-285, the good until option is an example of order priority type).**

Figure 2 from May is set forth below. Figure 2 depicts a system.

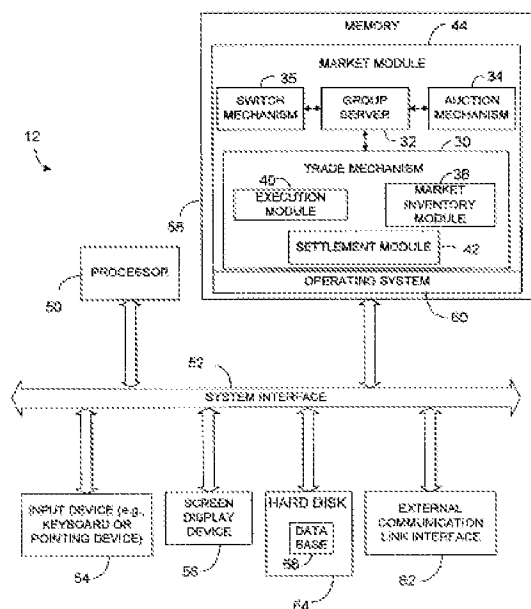


FIG. 2

Nothing in Figure 2 corresponds to: “the graphical user interface including a field to choose a priority type for how the order executes with contra side quotes/orders in the trading venue.”

Figures 14A and 14B from May are set forth below:

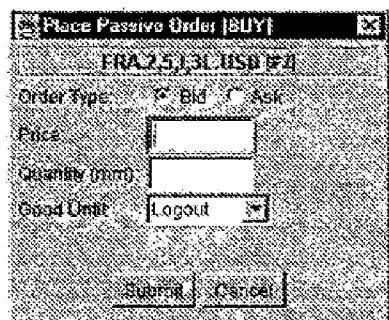


FIG. 14A

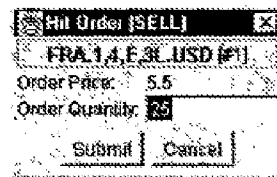


FIG. 14B

The text from May cited by the examiner is set forth below:

[0273] In specific regard to the ORD button in the function bar 290, a user can submit a passive order by selecting the ORD button. If the ORD button is selected, a passive order interface 294 is provided to the user, as illustrated in FIG. 14A. From the passive order interface 294, the user can place a passive order such as a bid (i.e., buy) or an ask (i.e., sell). The user enters a price, quantity, and selects how long the order will be good. The price will default to current market level so the user may only need to enter the last two digits of the price. For quantity, the system 10 recognizes m, mn and b for thousands, millions and billions, respectively. The system 10 allows the following order types to be entered under the good until option:

[0274] good until logout (default)—Requires the user to be logged on and to monitor the orders status.

[0275] good until time—The user will be prompted to enter a time (in his or her own time zone). This order does not require the user to be logged on and will be canceled automatically by the system 10 at the appropriate time.

[0276] good until canceled—This order again does not require the user to be logged on, but must be canceled by the user.

[0283] Thus, the user can execute both passive and active orders from either the market detail interface 302 or the market entry interface 250. At either interface 250, 302, if the user wants to execute a trade, then the user only need to highlight the desired bid or offer and select the corresponding function button from the respective function bar 290, 308 to initiate the transaction. Although the semantics of placing, changing, and canceling orders can be relatively complex, the user is shielded from this wherever possible by the system 10.

[0284] Each order entered into the system 10 is placed into a queue based on price and time received. A change to the order may or may not affect the order's place in the queue. Any change of price will move the order up or down in the queue depending on the price level. Any decrease in the volume of the order will not affect the order's place in the queue. Any increase in volume will result in the previous amount holding its place and a new order placed for the balance.

[0285] Effective electronic trading should be intuitive, fast and reliable. In order to facilitate this, the present invention is designed to maximize a user's efficiency. The system 10 enables the user to place passive orders from either the

market entry interface **250** or market details interface **302** using the input device **86**. For instance, the user may double click on the instrument name or may select the ORD button of the function bar **290, 308** in order to launch the passive order interface **294**

Nothing in these passages or elsewhere in May describes or renders obvious: "... the graphical user interface including a field ... to choose a priority type for how the order executes with contra side quotes/orders in the trading venue."

May describes what is meant by "priority" in [0316, 0320 and 0363]. For example, May describes: "[0316] ... The better submitted prices will have priority, and all orders at the auction-price are filled in proportion to each other." However, nothing in those paragraphs describes the claim feature. However, May's recognition of priority is at odds with the examiner's construction of May in that nothing in the discussion of priority in May relates to the features relied upon by the examiner. The examiner confuses execution "priority type" with an "order type" and therefore clearly shows that May does not teach the claimed feature. To advance prosecution, Applicant has clarified the feature to require "execution priority."

The examiner appears to take the position that "priority" as claimed is the same as "the type of order, e.g., "good till canceled." A good till canceled order neither describes nor suggests nor has any mechanism to control "a priority type" i.e., execution priority for how the order executes with contra side quotes/orders in the trading venue. It merely specifies the duration of time when the order, if still in the system is available for execution.

Accordingly, claim 1 is patentable over the cited art.

### Claim 2

Regarding claim 2, the examiner states: "... Official notice is taken that the feature wherein the client system is coupled to a network, the system further comprising: a server system coupled to the network that receives the order from the client system and executes the order against interest in the trading venue based on the priority type chosen by the user is old and well known."

Applicant contends that this official notice is in error. Applicant requests that the examiner furnish documentary proof of this assertion or remove the assertion. Specifically,

Applicant requests that the examiner furnish proof that execution of an order against interest in the trading venue "based on the priority type chosen by the user" is old and well known. While execution of orders is clearly well known, the examiner has yet to show an example of prior art where a graphical user interface to form an order has a field that allows the user to choose a priority type for how the order executes with contra side quotes/orders in the trading venue.

Applicant also contends that this official notice is improperly taken. The office cautions examiners to avoid taking official notice in circumstances as the instant case stating:

**It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. In re Ahlert, 424 F.2d at 1091, 165 USPQ at 420-21. See also In re Grose, 592 F.2d 1161, 1167-68, 201 USPQ 57, 63 (CCPA 1979).<sup>1</sup>**

Accordingly, the examiner should either find such a reference or retract this reasoning and official notice and allow the application.

Claim 29 includes the feature of instructions to: "determine from the received order, a priority type for how the order executes with contra side quotes/orders in the trading venue." Claim 29 is neither described nor rendered obvious by May for analogous reasons discussed above.

Claim 34 includes the feature of instructions to: "choosing by the client computer system populating the field in the graphical user interface rendered on the display, a priority type for how the order executes with contra side quotes/orders in the trading venue." Claim 34 is neither described nor rendered obvious by May for analogous reasons discussed above.

In this rejection the examiner states: "The limitation "a client system that displays a graphical user interface" is interpreted as an intended use of the client system without any bearing on how the order is received or executed by the computer system. Hence this limitation is not given patentable weight."

---

<sup>1</sup> MPEP 2144.03.



Applicant contends this reasoning is improper. The examiner must accord this feature patentable weight because it is how the method of trading through executing by the server computer is, in part, carried out by controlling execution priority type.

Similar arguments apply for Claim 45 in that May neither describes nor renders obvious "... instructions ... to: receive ... an order ... the order specifying a priority type for how the order executes with contra side quotes/orders in the market, determine from the order the priority type specified by the order; and execute the order ... in accordance with the priority type specified by the order."

Claims 17, 32, 44 and 49 further distinguish over May. Claims 5, 31, and 37 further distinguish over May requiring that "one of the priority types is price/time priority, as in claim 5 for example.

The examiner rejected Claims 3, 4, 6-16, 30, 35-36, 38, 39, 41-43 and 46-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over May in view of NASD Rulemaking (Reference U in PTO-892 mailed March 18, 2008).

Claims 3, 4, 6-16, 30, 35-36, 38, 39, 41-43 and 46-48, May teaches a system, a computer program product and a method of claims 1,29,34,40 and 45 respectively as discussed above.

The examiner acknowledges that May does not explicitly teach the features of claims 3, 4, 6-16, 30, 35-36, 38, 39, 41-43 and 46-48. The examiner relies on NASD rulemaking arguing that it would have been obvious to combine NASD with May.

Applicant submits that these claims serve to further differentiate over the alleged combination of May and NASD. NASD does not cure the deficiencies in May for reasons of record, specifically no combination of May with NASD suggest: "... a display ... rendering a graphical user interface ... to form the order ... including a field that allows the user to choose a priority type for how the order executes with contra side quotes/orders in the trading venue," as recited in base claim 1.

Applicant : Dean Furbush et al.  
Serial No. : 09/903,388  
Filed : July 9, 2001  
Page : 20 of 20

Attorney's Docket No.: 09857-0061001 / P1105US00

The Petition for Extension of Time fee is being paid concurrently on the electronic filing system by way of deposit account authorization. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: September 13, 2011

/Denis G. Maloney/  
Denis G. Maloney  
Reg. No. 29,670

Customer Number 26161  
Fish & Richardson P.C.  
Telephone: (617) 542-5070  
Facsimile: (877) 769-7945

22665704.doc